



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,912	03/26/2004	Junichiro Hosokawa	Q80656	7693

23373 7590 06/20/2006
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,912

Applicant(s)

HOSOKAWA ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: _____ |

This is in response to Papers filed on 30 may 2006.

- I. The instant specification on page 5, line 6 as pointed out by applicants that the claimed compound has “its coloring property”. There is no teaching or suggestion that the claimed compound has no coloring property as urged. Therefore, the arguments are not found to be convincing. There is no objection and rejection over the issue of new matter as urged. It is conventional in the art to use more than one color coupler agent. The instant claims are read two or more color coupler agents with (1) “a coloring coupler” #1 and (2) a color coupler “compound” “C” “other than the coloring coupler” #1.
- II. Claims 21-23, 25 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuoka et al (5,384,236).

Matsuoka et al disclose and teach a method for using a compound being reasonably read within the general formula © as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. A color coupler other than

Art Unit: 1752

that in the general formula ©. Please see the whole disclosure of the applied reference, especially at col.2:6 and 16 to 8:2, compounds (1) to (57), 32:54-56, 56:39-42, Examples, Table B on cols.63 and 64, 65:50-60 and 68:9-11.

Matsuoka et al do not specify the properties with respect to “Hammett...value...to 1.0”, “change a film...to 3.0” as that in claim 22, “pKa value...to 8.4” as that in claim 23 and “reactivity...to 1.0” as that in the original claim 28. Since they are all related to the properties of the materials, (1) it is reasonable to consider inherent in the absence of a convincing evidence to the contrary and (2) it is allowed by the court of law to request and required applicants to show or provide a convincing evidence to the contrary in accordance with the authority stated in re Schreiber, 44 USPQ2d 1429.

Since Matsuoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Matsuoka et al.

Applicant's arguments filed 30 May 2006 have been fully considered but they are not persuasive.

The instant specification on page 5, line 6 as pointed out by applicants that the claimed compound has “its coloring property”. There is no

teaching or suggestion that the claimed compound has no coloring property as urged.

(1) Accordingly, an allowed claim or a patent would have no value when someone later shows that a compound being read on or within the general formula © has a color property other than those as urged.

(2) However, there is no objection and rejection over the issue of new matter as urged. It is conventional in the art to use more than one color coupler agent. The instant claims are read two or more color coupler agents with (1) “a coloring coupler” #1 and (2) a color coupler “compound” “C” “other than the coloring coupler” #1.

III. Claims 21-23, 25 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagaoka et al (5,460,929).

Nagaoka et al disclose and teach a method for using a compound being reasonably read within the general formula © as claimed in a silver halide color photographic material and rapidly processing the material based on the light fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. A color coupler other than

Art Unit: 1752

that in the general formula ©.Please see the whole disclosure of the applied reference, especially at col.1:8-9, 9:14 to 14:67, compounds (1) to (48), 39:3-5, Examples, “Emulsion D” on col.176:26 and on col.179 with respect to the top Table on left column of “Emulsion” from C then to D and on col.182 with Table 84 with “6th” layer.

Nagaoka et al do not specify the properties with respect to “change a film...to 3.0” as that in claim 22, “pKa value...to 8.4” as that in claim 23 and “reactivity...to 1.0” as that in the original claim 28. Since they are all related to the properties of the materials, (1) it is reasonable to consider inherent in the absence of a convincing evidence to the contrary and (2) it is allowed by the court of law to request and required applicants to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Nagaoka et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Nagaoka et al.

Applicant's arguments filed 30 May 2006 have been fully considered but they are not persuasive.

The instant specification on page 5, line 6 as pointed out by applicants that the claimed compound has “its coloring property”. There is no teaching or suggestion that the claimed compound has no coloring property as urged.

(1) Accordingly, an allowed claim or a patent would have no value when someone later shows that a compound being read on or within the general formula © has a color property other than those as urged.

(2) However, there is no objection and rejection over the issue of new matter as urged. It is conventional in the art to use more than one color coupler agent. The instant claims are read two or more color coupler agents with (1) “a coloring coupler” #1 and (2) a color coupler “compound” “C” “other than the coloring coupler” #1.

IV. Claims 21-23, 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mihayashi et al (5,543,282).

Mihayashi et al disclose and teach a method for using a compound being reasonably read within the general formula © as claimed in a silver halide color photographic material and rapidly processing the material based on the light

Art Unit: 1752

fastness property of the compound in a red sensitive layer. The layer contains tabular silver halide grains having an aspect ratio of 8. A color coupler other than that in the general formula ©. Please see the whole disclosure of the applied reference, especially at col.1:13:6, 3:25 to 10:22, compounds (1) to (52), 37:2-4, 38:51-52, Examples, col.68 with respect Emulsion 5 on Table 1 and Samples 116 and 117 on Table 3 at cols. 87 and 88, 89:34, Table 5 with “Emulsion” “7-1” and “8-1” on cols. 95 and 96, Table 6 with “Sample” “303”, “304”, “307”, “308”, “311” and 312” on cols. 97 and 98.

Mihayashi et al do not specify the properties with respect to “change a film...to 3.0” as that in claim 22, “pKa value...to 8.4” as that in claim 23 and “reactivity...to 1.0” as that in the original claim 28. Since they are all related to the properties of the materials, (1) it is reasonable to consider inherent in the absence of a convincing evidence to the contrary and (2) it is allowed by the court of law to request and required applicants to show or provide a convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since Mihayashi et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Mihayashi et al.

Applicant's arguments filed 30 May 2006 have been fully considered but they are not persuasive.

The instant specification on page 5, line 6 as pointed out by applicants that the claimed compound has "its coloring property". There is no teaching or suggestion that the claimed compound has no coloring property as urged.

(1) Accordingly, an allowed claim or a patent would have no value when someone later shows that a compound being read on or within the general formula © has a color property other than those as urged.

(2) However, there is no objection and rejection over the issue of new matter as urged. It is conventional in the art to use more than one color coupler agent. The instant claims are read two or more color coupler agents with (1) "a coloring coupler" #1 and (2) a color coupler "compound" "C" "other than the coloring coupler" #1.

V. The above applied references are insufficient to applied against claim 26.

However, the teachings and suggestions in the prior art submission filed on 04

Art Unit: 1752

June 2004 may be sufficient to applied against it as that on the record in the Foreign Office Action as submitted. Applicants have not early and timely provide English language translations of pertinent portions or English language equivalents of the applied Japanese patents should have been timely provided for a proper consideration and examination. For the record, claim 26 (1) is not rejected over the above references (2) may be provisionally rejected over the teachings and suggestions in the applied Japanese patents as that on the record in the Foreign Office Action. English language translations of pertinent portions or English language equivalents of the applied Japanese patents

VI. Exhibits A-E filed on 30 May 2006 have been considered. In Exhibit C, the applied JP 51-059943 has its English equivalent to GB 1 504 950. The JP 51-059943 is withdrawn from the rejection in the next paragraph.

VII. Claim 26 is provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over the teachings and suggestions of one or more of the Japanese Patents with respect to JP 2000-181002, JP 11-119364, JP 54-32552 and JP 2001-133931 for the reasons as stated in the Foreign Office Action as submitted. Accordingly, English language translations of pertinent portions or English language equivalents of the applied Japanese patents must be timely

provided before a brief on appeal is filed. Otherwise, the appeal will not be considered and is dismissed.

Applicants state that they will provide a pertinent portion of the applied foreign references in English language on 19 October 2005 being acknowledged.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available

Art Unit: 1752

through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
13 June 2006

HOA VAN LE
PRIMARY EXAMINER
